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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,662	04/05/2001	Larry J. Wilson	4660/5000	5703
757	7590	02/08/2005		
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER SAETHER, FLEMMING				
ART UNIT		PAPER NUMBER		
3677				

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

## Office Action Summary

Application No.

09/828,662

Applicant(s)

WILSON, LARRY J.

Examiner

Flemming Saether

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 22, the diameter of the cap cannot be less than that of the insert when it press-fit therein as claim 21 has been amended to recite.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 15-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-38 of copending Application No. 10/303,564. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

Claims 1, 3, 5, 6, 8, 10, 15, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Baltzell (US 4,764,070). Baltzell discloses a decorative cap (12) on a threaded insert (10). The insert includes a polygonal portion (16) and a cylindrical portion (28). The cap includes a polygonal (30) and cylindrical (36) portion conforming to those of the insert. The cylindrical portion of the insert is received in the cylindrical portion of the cap and pressed inward (column 3, line 1); the cap is further crimped (at 52) which forms a free edge under a shoulder. The insert is furthermore provided with a coating (50) which is chromium free. The cap being deformed radially outwardly by elastically and un-elastically including the amount of deformation is a product-by-process limitation wherein it only the final product which is considered for patentability. See In re Marosi, 218 USPQ 289 (Fed. Cir. 1983).

***Claim Rejections - 35 USC § 103***

Claims 2, 4, 9, 16, 17, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baltzell. Baltzell does not disclose the specific dimensions and materials as claimed. The examiner contends that the dimensions claimed would have been recognized depending upon the materials and use of the invention furthermore; there is no criticality to the dimensions and materials. It would have been obvious to remove the glue since it had recognized obvious to remove an element if function is not critical. The examiner takes notice that it is well known to make cap of stainless steel.

***Claim Rejections - 35 USC § 103***

Claims 1-6, 8-10 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toth (US 4,775,272) in view of Toth (US 5,302,069). In the embodiment of Fig. 10, Toth '272 discloses a decorative cap (not labeled) on a threaded insert (not labeled). The insert includes a polygonal portion and a cylindrical portion (at 114). The cap includes a polygonal (30) and cylindrical (102) portion conforming to those of the insert. Toth '272 discloses the cylindrical portion of the cap welded onto the cylindrical portion of the insert (at 108). Toth '069 discloses decorative cap on a threaded insert and teaches the equivalence of welding and a force fit (column 4, line 37-39) wherein the force fit would inherently include an expansion to provide tensile hoop stress once in the assembled condition. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the welding in Toth '272 with a force fit in view of the teaching in Toth '069. The force fit would be superior to welding in the ease and time of assembly which would be advantageous depending on the intended application. Toth '069 further describes a its well known to provide a coating onto the insert and to make the cap of stainless steel. The examiner contends that the dimensions claimed would have been recognized depending upon the materials and use of the invention furthermore; there is no criticality to the dimensions and materials. The cap being expanded elastically and un-elastically including the

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amount expansion relative to its pre-assembled state is again a product-by-process limitation wherein it only the final product which is considered for patentability.

### ***Allowable Subject Matter***

Claim 7 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims along with a proper Terminal Disclaimer.

### ***In Response to Remarks***

Applicant argues that in Baltzell the contacting through a full 360 degrees in insufficient to teach the interference fit. In response, the examiner disagrees because the 360 degree of contact would provide at least some small amount of interference fit even if the members could be relatively slidable. Indeed, the claims do not preclude members from being slidable relative to one another, in fact, in the instant invention; the cap is slid relative to the insert during assembly.

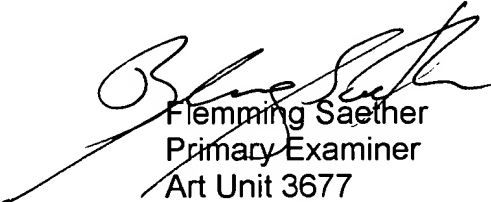
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Flemming Sæther  
Primary Examiner  
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